

NEFFELD Docket No.: CAT/34-SCRO-CCP

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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IN RE APPLICATION OF:

GROUP ART UNIT: 2163

JUN 17 2004

MICHAEL C. SCROGGIE, et al.

**OFFICE OF PETITIONS**

SERIAL NO.: 09/505,632

EXAMINER: AKIKA ROBINSON-BOYCE

FILED: 02/16/00

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JUN 24 2004

Assistant Commissioner for Patents

**GROUP 3600**

Washington, D.C. 20231

37 CFR 1.181 PETITION FOR WITHDRAWAL OF AN OFFICE ACTION, REMOVAL OF  
FINAL STATUS, AND ISSUANCE OF A NOTICE OF ALLOWANCE

**I. Statement of Precise Relief Requested**

The applicant requests that the Director (1) remove the "final status" of this application, (2) withdraw the final office action mailed April 6, 2004, and (3) issue a notice of allowance.

**II. Statement of Material Facts**

1. On October 27, 2003, the Board mailed a decision on the **appeal** in this application.
2. The October 27, 2003 decision (1) reversed the prior art rejections of claims 28, 40, 24-27, 29-31, 36-39, 41-43, 48, and 49 **based solely upon the Sloane, Hoffman, and Smolen references** and (2) sustained the rejections of claims 34 and 46.
3. The Board decision contains no suggestion or instruction to reject or new rejection of any claim.
4. A copy of the Board decision mailed October 27, 2003 is attachment 1.
5. On April 6, 2004, the USPTO mailed a "final" office action. (The April 6, 2004 office action states that it is "FINAL".)
6. The April 6, 2004 final office action imposes rejection of claims 28, 40, 24-27, 29-31, 36-

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39, 41-43, 48, and 49 **based solely upon Sloane, Hoffman, and Smolen.**

7. The April 6, 2004 office action also rejects new claim 50 and 51 based solely on Sloane. However, new claims 50 and 51 define subject matter that the Board held to not be taught by Sloane, Hoffman, and Smolen. See page 7 of the amendment filed December 8, 2003.
8. A copy of the amendment filed December 8, 2003 is attachment 3.
9. The April 6, 2004 office action is not signed by a Group director, and it does not otherwise the Group director authorized reopening of prosecution after a decision on appeal.
10. The MPEP indicates that Group director must specifically approve reopening prosecution after a decision on appeal.
11. A copy of the April 6, 2004 office action is attachment 2.

### **III. Reasons Why the Relief Requested Should be Granted**

The examiner is not authorized to reopen prosecution without the authority and presumably signature proving such of the Group director, after a decision on an appeal. Accordingly, the mailing of an office action is improper and should be withdrawn.

The rejections in the office action are barred by res judicata, since all issues that were and could have been raised are decided by an appeal. Clearly the almost identical set of rejections based upon the exact same three references imposed in the April 6, 2004 office action are barred by the decision on the same evidence and essentially the same arguments in the appeal.

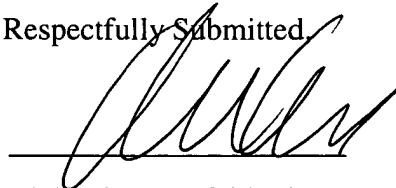
In any case, final status is improper when an examiner opens prosecution, final status is improper when an examiner imposes a new rejection not necessitated by action by the applicant, and both of those situations exist here.

Given that the Director's policy warrants that the unauthorized office action be withdrawn and that the basis for rejections in the office action is precluded as a matter of law, the only action open to the USPTO is to issue a notice of allowance. Accordingly, the relief requested should be granted in full, and a decision on this petition should so instruct the examiner.

Respectfully Submitted,

6/9/04

Date



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Date/Time: June 9, 2004 (2:27pm)

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